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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 724,872	11 28 2000	Gyula Hadlaczky	24601-402F	8394

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EXAMINER

HELMER, GEORGIA L.

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 07 16 2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/724,872

Applicant(s)

HADLACZKY ET AL.

Examiner

Georgia Helmer

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-33 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other

Art Unit: 1638

### **DETAILED ACTION**

1. The previous Restriction Requirement of April 16, 2002, is hereby vacated in favor of the requirement set forth below. The reason for this action is to allow for additional inventions identified by the instant examiner. However, the traverse of the previous requirement applies to the instant requirement. Therein, Applicant argued that the previous requirement was improper since there would be no search burden by virtue of the fact that this application is a continuation-in-part (CIP) of two patents claiming satellite artificial chromosomes (SATACs). As a result, Applicant asserts that SATACs are presumptively novel, unobvious and enabled. Initially, the Office notes that the instant claims are directed to methods of use of plant and animal SATAC. Before the merits of Applicant's traverse can be adequately addressed, the actual scope of the claims covering SATACs must be compared to the scope of the claims covering the methods of use. In accordance with the Office's rejoinder policy, if the methods of use claims include all the limitations of allowable (patented) product claims, then the method claims are presumed to define over the prior art. Nonetheless, enablement questions may still remain. Here, the method claims broadly recite use of SATACs without any specificity as to their structure. The patented claims are more detailed and accordingly, there is no presumption of allowability over the prior art. As to the possibility of never getting a generic claim examined, the Office notes that the corrected requirement set forth below provides for examination of the generic claims under linking claim practice.

Art Unit: 1638

***Election/Restriction***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 4, 6, 7, 16, 20, 29 and 30, drawn to a method for transforming a plant cell by introducing a plant satellite artificial chromosome (SATAC) into the cell, classified in class 800, subclass 278.
  - II. Claims 5, 6, 8, 16 and 20, drawn to method for transforming a plant cell by introducing an animal SATAC into the cell, classified in class 435, subclass 419.
  - III. Claims 2-4, 16, 20, 28, 29 and 33, drawn to a method for transforming an animal cell by introducing a plant SATAC into the cell, classified in class 435, subclass 325.
  - IV. Claims 2, 3, 5, 16, 20, 28 and 33, drawn to a method for transforming an animal cell by introducing an animal SATAC into the cell, classified in class 514, subclass 44.
3. The inventions are distinct, each from the other because of the following reasons:

Inventions I-IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are mutually exclusive. In addition, the materials used by each of the methods differ in structure and function. Plant cells are structurally different from animal cells. Further plant cells require different transformation sequences than animal cells. Promoters that act in animal cells

Art Unit: 1638

usually are not functional in animal cells. Plant cells glycosylate differently from animal cells. The proteases present in animal cells differ from those in plant cells. Plant SATACs that are used in animal cells must be changed to allow for expression in an animal cell whereas they can be used directly in plant cells.

4. Claims 1, 9-15, 17-19, 21-27, 31 and 32 link(s) inventions I-IV. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s). Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application.

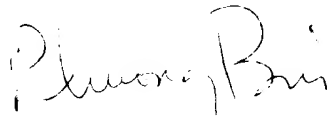
Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, searches and divergent subject matter, restriction for examination purposes as indicated is proper.

Art Unit: 1638

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).
7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Georgia Helmer whose telephone number is 703-308-7023.

Georgia Helmer  
Patent Examiner  
Art Unit 1638  
July 15, 2002

  
PHUONG T. BUI  
PRIMARY EXAMINER